



AF 12176/17
PATENT IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: BATES ET AL.

Application: METHOD AND COMPUTER PROGRAM PRODUCT FOR IDENTIFYING
HYPERTEXT LINKS IN DOCUMENT PRINTOUTS

Serial No.: 09/292,444

Filing Date: April 15, 1999

Art Unit: 2176

Examiner: Rachna Singh

Case: RO998-222

CERTIFICATE OF MAILING: I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed for Commissioner of Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on

October 24, 2005 *Joan Pennington*
Date of Deposit Signature

Joan Pennington

Name of person signing

535 North Michigan Avenue
Unit 1804
Chicago, Illinois 60611

Mail Stop **Appeal Brief-Patents**
Honorable Commissioner Of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF TRANSMITTAL


Sir:

An Appeal Brief for Applicants is being submitted herewith. Please charge the Deposit Account No. 09-0465 of International Business Machine Corporation in the amount of \$500.00 for the fee for filing a brief in support of the appeal (37 CFR §41.20(b)(2) fee code 1402).

Serial No.: 09/292,444

The Commissioner of Patents and Trademarks is hereby authorized to charge any additional fees or credit any overpayment in connection with the filing of the above-referred to Appeal Brief to the Deposit Account No. 09-0465 of International Business Machine Corporation. A duplicate copy of this transmittal is enclosed.

Respectfully submitted,

By 
Joan Pennington
Reg. No. 30,885
Telephone: 312/670-0736
One of the Attorneys for Applicants

Enclosures



PATENT

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: BATES ET AL.

Application: METHOD AND COMPUTER PROGRAM PRODUCT FOR IDENTIFYING
HYPERTEXT LINKS IN DOCUMENT PRINTOUTS

Serial No.: 09/292,444

Filing Date: April 15, 1999

Art Unit: 2176

Examiner: Rachna Singh

Case: RO998-222

CERTIFICATE OF MAILING: I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed for Commissioner of Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on

October 24, 2005
Date of Deposit

Joan Pennington
Signature

Joan Pennington
Name of person signing

APPEAL BRIEF FOR APPLICANTS

JOAN PENNINGTON
535 North Michigan Avenue
Unit 1804
Chicago, Illinois 60611

One of the Attorneys for Applicants

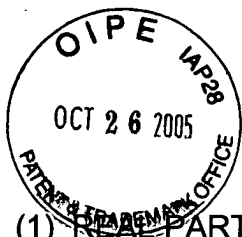


TABLE OF CONTENTS

	<u>Page</u>
(1) REAL PARTY IN INTEREST.....	2
(2) RELATED APPEALS AND INTERFERENCES.....	2
(3) STATUS OF CLAIMS	2
(4) STATUS OF AMENDMENTS	2
(5) SUMMARY OF INVENTION	2
(6) <u>GROUND OF REJECTIONS TO BE REVIEWED ON APPEAL</u>	8
(7) ARGUMENT.....	9
A. INTRODUCTION	9
B. THE SCOPE AND CONTENT OF THE PRIOR ART.....	9
C. THE REJECTION OF CLAIMS 1-3, 6, 10, 12-14, 16 and 17 AS BEING ANTICIPATED BY STORK et al. SHOULD BE REVERSED.....	12
Claims 1-2, 6 and 14 are patentable	12
Claim 3, 12, and 16 are patentable	18
Claim 10 is patentable	19
Claim 13 is patentable	21
Claim 17 is patentable	22
D. THE REJECTION OF CLAIMS 4, 5, 8 SHOULD BE REVERSED	23
Claim 4, 5, and 8 are patentable	23
E. THE REJECTION OF CLAIMS 7, 9 SHOULD BE REVERSED	26
Claim 7 and 9 are patentable	26
F. CONCLUSION.....	27
(8) APPENDIX.....	28
CLAIMS ON APPEAL	
(9) EVIDENCE APPENDIX.....	33
DRAWINGS OF INVENTION	

TABLE OF CITATIONS

	<u>Page</u>
<u>Akzo N.V. v. U.S. Intern. Trade Com'n,</u> 808 F.2d 1471, 1479 (Fed. Cir. 1986)	20
<u>B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.</u> 72 F.3d 1577, 37 USPQ2d 1314 (Fed. Cir. 1996)	25
<u>In re Bond</u> 910 F.2d 831 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)	23
<u>Carl Schenck, A.G. v. Nortron Corp.</u> 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)	24
<u>Environmental Designs, Ltd. v. Union Oil Co.</u> 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983)	25
<u>In re Fine</u> 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)	23
<u>In re John R. Fritch</u> 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992)	24
<u>In re Gordon and Sutherland</u> 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1983)	24
<u>Graham v. John Deere</u> 383 U.S. 1, 148 USPQ 459, (1966)	24
<u>Hybritech Inc. v. Monoclonal Antibodies, Inc.</u> 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986)	23
<u>Kalman v. Kimberly-Clark Corp.,</u> 713 F.2d 760, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)	13
<u>In re King</u> 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986)	12
<u>Leinoff v. Louis Milona & Sons, Inc.,</u> 726 F.2d 734, 220 U.S.P.Q. 845 (Fed. Cir. 1984)	16
<u>Richdel, Inc. v. Sunspool Corp.</u> 714 F.2d 1573, 219 USPQ 8 (Fed. Cir. 1983)	25

<u>Sensonics, Inc. v. Aerosonic Corp.</u> 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996)	26
--	----

<u>In re Sernaker</u> 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983)	24
--	----

<u>In re Young</u> 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991)	24
---	----

TABLE OF OTHER AUTHORITIES

35 USC §102(e).	12
35 U.S.C. §103.	24



PATENT

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: BATES ET AL.

Application: METHOD AND COMPUTER PROGRAM PRODUCT FOR IDENTIFYING
HYPERTEXT LINKS IN DOCUMENT PRINTOUTS

Serial No.: 09/292,444

Filing Date: April 15, 1999

Art Unit: 2176

Examiner: Rachna Singh

Case: RO998-222

CERTIFICATE OF MAILING: I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed for Commissioner of Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on

October 24, 2005 Joan Pennington Joan Pennington
Date of Deposit Signature Typed/printed name of person signing

535 North Michigan Avenue
Unit 1804
Chicago, Illinois 60611

Mail Stop **Appeal Brief Patent**
Honorable Commissioner Of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF FOR APPLICANTS

Sir:

This is an appeal of the final rejection of claims 1-10, 12-14 and 16-17 under 35 U.S.C. §102 and 35 U.S.C. §103 mailed July 8, 2005. For the reasons set forth below, it is submitted that the Board should reverse the final rejection of claims 1-10, 12-14 and 16-17.

(1) REAL PARTY IN INTEREST

The real party of interest is International Business Machines Corporation.

(2) RELATED APPEALS AND INTERFERENCES

Applicants' attorney knows of no other appeals or interferences that would have a bearing on the Board's decision in the present appeal.

(3) STATUS OF CLAIMS

Claims 1-10, 12-14 and 16-17 have been finally rejected as unpatentable under 35 U.S.C. §102 and 35 U.S.C. §103 mailed July 8, 2005. The rejection of each of the claims 1-10, 12-14 and 16-17 has been appealed.

(4) STATUS OF AMENDMENTS

No amendment was filed after the final rejection of claims 1-10, 12-14 and 16-17.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention as recited by independent claims 1, 10, 13, and 17 can best be appreciated and understood with reference to the patent specification (hereinafter, specification page p., line or lines l.) and drawings attached in 9) Evidence Appendix (Sheets 1-5).

The invention is a method, apparatus and computer program product for identifying hypertext links in document printouts. A document to be printed is scanned for identifying local hypertext links within the document. A page location of each identified local hypertext links within the document is computed and stored. Printable objects are sequentially checked to identify each printable object within a hypertext

anchor tag. Each identified printable object within a hypertext anchor tag is rendered with a predefined indication of the hypertext link. (p. 2, l. 5-12).

In accordance with features of the invention, a local hypertext link is printed with a page number of the hypertext link within the document. An external hypertext link is printed with a uniform resource locator (URL) for the external hypertext link. The page number of the hypertext link within the document and the uniform resource locator (URL) for the external hypertext link can be printed, for example, in superscript form and bolded or with other highlighting. (p. 2, l. 13-19).

In FIGS. 1A and 1B, there is shown a computer or data processing system generally designated by the reference character 100 for carrying out the document printing method for identification of hypertext references of the preferred embodiment. As shown in FIG. 1, computer system 100 includes a central processor unit (CPU) 102, a read only memory 103, a random access memory 104, a display adapter 106 coupled to a display 108. CPU 102 is connected to a user interface (UI) adapter 110 connected to a pointer device and keyboard 112. CPU 102 is connected to an input/output (IO) adapter 114 connected to a direct access storage device (DASD) 116 and a tape unit 118. CPU 102 is connected to a communications adapter 120 providing a communications function. It should be understood that the present invention is not limited to a computer model with a single CPU, or other single component architectures as shown in FIG. 1. (p. 3, l. 7-20).

As shown in FIG. 1B, computer system 100 includes an operating system 130 and a hypertext link identification printing program 132 of the preferred

embodiment. In accordance with features of the invention, a document printout provides identification of internal or local and external hypertext links or references. A table of document data 200 is stored for identifying local hypertext links in a document printout of the preferred embodiment. Various commercially available computers can be used for computer system 100, for example, an IBM personal computer. CPU 102 is suitably programmed by the hypertext link identification printing program 132 to execute the flowcharts of FIGS. 3 and 4. (p. 3, l. 21-30).

In accordance with features of the invention, hypertext links are easily identified when printing documents. For a local or internal hypertext reference with hypertext pointing to a section of the document that is within the same URL (an internal reference), the page number is calculated and inserted into the document printout. The internal hypertext reference text or hot text may be bolded or highlighted in various ways, and the page number is inserted in superscript or in parenthesis or the like. An internal hypertext reference text may be printed as shown in the following Table 1:

Table 1

Roof shingles should be attached with **shingle nails** (page 15)

where "shingle nails" is the internal hypertext reference text to another portion of this document and the "page 15" is inserted at print time as a superscript, generated by the print function based on the current printer selected and the current font settings, margins, etc. that control the pagination for a given printout. It should be understood

that the superscript may further describe where on page 15 where the referenced text appears, such as, to a paragraph number or to a line number. (p. 3, l. 31 - p. 4, l.17).

In accordance with features of the invention, for an external hypertext reference with the hypertext pointing to a URL address external to the current document, the URL address is inserted into the printout, for example, in a superscript or other font at the point in the text where the hypertext appears or as a footnote with a footnote reference in the text. For example, an external hypertext reference text may be printed as shown in the following Table 2:

Table 2

You should frame art in quality **picture**

frames(http://www.Picture_Frames_Catalogue.com)

where "picture frames" is hypertext to an external URL and the URL is printed as enclosed in parenthesis and in superscript. The reader is alerted that "picture frames" is hypertext to an external URL, and is also given the URL. (p. 4, l. 18-31).

Footnotes containing the URL addresses can appear either at page bottom or grouped together on a separate page. With the URL addresses printed, the user can note the URL and then logon to the Internet to navigate to the given addresses if desired. For example, a group of external hypertext references may be printed in a footnote as shown in the following Table 3:

Table 3

picture frames¹

art²

*** * ***

Footnotes:

¹ (http://www.Picture_Frames_Catalogue.com)

² (http://www.Art_Gallery_Catalogue.com) (p. 5, l. 1-14).

Referring now to FIG. 2, document data 200 of the preferred embodiment is illustrated. The document data 200 is a table containing each local anchor name 202 from the `` tag together with a page number 204 identified in a particular document to be printed. A print routine of the preferred embodiment, illustrated and described with respect to FIG. 4, first scans the particular document to be printed and determines the page on which all such anchor tags 202 appear. Then the local anchor names 202 and page number 204 are stored in document data 200. When printing the document, when a `` is found, the page number is retrieved from document data 200 and printed, for example, as a superscript after the printable data enclosed by the `PRINTABLE DATA` tag. (p. 5, l. 15-30).

Referring now to FIGS. 3 and 4, exemplary steps are shown for implementing document printing including the identification of hypertext links in document printouts in accordance with the preferred embodiment. In FIG. 3, a main

browser flow routine is shown starting at a block 300. An event is obtained as indicated in block 302. Checking whether the event is a print event is performed as indicated in a decision block 304. When a print event is identified, a routine is performed to print the current page with hypertext link annotation as indicated in block 308. Otherwise, when the event is not a print event, all other browser events are handled in the normal way. (p. 5, l. 31 - p. 6, l. 7).

Referring now to FIG. 4, exemplary steps of the print routine of the preferred embodiment are shown starting at a block 400. First as indicated in block 402, the document is scanned, computing a page location of all `` tags in the document and the computed page number 204 is stored with the name 202 in the document data. Then sequential operations start with a first printable object as indicated in block 404. A printable object is defined such that only one printable object can be in an anchor tag. Checking for more printable objects is performed as indicated in a decision block 406. When another printable object is identified, checking whether the printable object is within an anchor tag is performed as indicated in a decision block 410. When the printable object is not within an anchor tag, then the printable object is rendered in the normal fashion as indicated in block 412. If true that the printable object is within an anchor tag, then checking for a local hypertext reference is performed as indicated in a decision block 414. When a local hypertext reference is not identified, then checking for an external hypertext reference is performed as indicated in a decision block 416. When an external hypertext reference is identified, then the printable object is rendered in normal fashion as indicated in block 418. Then the URL

for the external hypertext reference is rendered, for example, in superscript form and may be printed bold or with other highlighting, as indicated in block 420. When a local hypertext reference is identified at block 414, then the printable object is rendered in normal fashion as indicated in block 422. Then the name for the local hypertext reference is found in the document data and a page number is printed, for example, in superscript form as indicated in block 424. (p. 6, l. 8-33).

Referring now to FIG. 5, an article of manufacture or a computer program product 500 of the invention is illustrated. The computer program product 500 includes a recording medium 502, such as, a floppy disk, a high capacity read only memory in the form of an optically read compact disk or CD-ROM, a tape, a transmission type media such as a digital or analog communications link, or a similar computer program product. Recording medium 502 stores program means 504, 506, 508, 510 on the medium 502 for carrying out the methods for implementing document printing to identify hypertext links in document printouts of the preferred embodiment in the system 100 of FIGS. 1A and 1B. (p. 6, l. 34 - p. 7, l. 8).

A sequence of program instructions or a logical assembly of one or more interrelated modules defined by the recorded program means 504, 506, 508, 510, direct the computer system 100 for implementing document printing and identifying hypertext links in document printouts of the preferred embodiment. (p. 7, l. 9-13).

(6) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-3, 6, 10, 12-14, 16 and 17 are unpatentable under 35 USC §102(e) as being anticipated by Stork et al., U.S. patent 5,781,914?

Serial No. 09/292,444

Whether claim 4, 5, and 8 are unpatentable over Stork et al., U.S. patent 5,781,914 in view of publication Microsoft Word Tutorial "Microsoft Word Basic Features" under 35 U.S.C. § 103?

Whether claim 7 and 9 are unpatentable over Stork et al., U.S. patent 5,781,914 in view of publication Advanced Microsoft Word "Footnotes and Endnotes" under 35 U.S.C. § 103?

(7) ARGUMENT

A. INTRODUCTION

Applicants respectfully submit that the Examiner's rejections should be reversed because the subject matter of each of independent claims 1, 10, 13, and 17 is patentable over all the references of record. Applicants respectfully submit that the rejection of claims 1-3, 6, 10, 12-14 and 16-17 under 35 USC 102(e) is incorrect, the claims are directed to novel subject matter and the total teachings of the Stork et al. would not achieve the claimed invention as recited by claims 1-3, 6, 10, 12-14 and 16-17.

As recited by independent claims 1, 10, 13, and 17, the methods, apparatus and computer program product for identifying hypertext links in document printouts includes means and steps that are not described, nor suggested in the references of record. Also Applicants respectfully submit that there is no teaching or suggestion in any of the cited references, individually or taken as a whole, to make the claimed invention obvious. Considering the scope and content of the prior art and the subject matter of the Stork et al., U.S. patent 5,781,914, publication Microsoft Word

Tutorial "Microsoft Word Basic Features", and publication Advanced Microsoft Word "Footnotes and Endnotes" requires a conclusion that the final rejections of the pending claims 1-10, 12-14 and 16-17 under 35 U.S.C. §102(e) and 35 U.S.C. §103 are improper and should be reversed.

B. THE SCOPE AND CONTENT OF THE PRIOR ART

Stork et al., U.S. patent 5,781,914 discloses a conversion method and apparatus that allows for converting a hardcopy document into a hyperdocument and vice versa. During hardcopy to hyperdocument conversion, hypertext information stored on the hardcopy document is used to set up links to other documents. During hyperdocument to hardcopy document conversion, hypertext link information is encoded and stored on the hardcopy document. A process is described where a hypertext document is converted into a plain paper document. One embodiment of this process is shown in FIG. 5. The hardcopy document that results contains hypertext link information in machine readable format to enable conversion back into a hypertext document format. Thus, the link information will be available to the user to enable a reversal back into a hypertext document. Referring to FIG. 5, the conversion process begins by creating a bit map of a hyperpage that is currently displayed on the display screen from a screen "dump" (processing block 501). An example of such a document is shown in FIG. 6A. A portion of the bit map is shown in FIG. 6B. Once a bit map has been created, the hyperwords in the bit map are detected (processing block 502). In one embodiment, the hyperwords are detected by using a template. Such a template is shown in FIG. 6D. The bit map locating portions of the bit map are searched with the template,

generating correlation values. FIG. 6E illustrates correlation values around the boxed region shown in FIG. 6C. The correlation value indicate whether there is a high correlation between portions of the document and the template. Once the marked words have been identified, the location and hyperlink information is encoded (processing block 503), the information is formatted into one or more pages (processing block 504), and a hardcopy document is printed having a sidechannel with encoded hyperlink information (processing block 505). Stork, at column 5, lines 1-30 states:

The information contained in the encoded information 101 is associated with key words and figures and their hyperlinks. In one embodiment, the encoded information 101 for text may identify the location of the key words in the text portion and its associated link information specifying the document (or portion thereof) that is to be retrieved upon selection of the active region. In one embodiment, the key word is actually included in the encoded information. In such case it would be the responsibility of the conversion system to locate that key word in the text, via search, to associate its hyperlink information. In another embodiment, the encoded information 101 may not contain the key word, but instead contain its location. Its location may be specified by the location of the start of a key word or may be in the form of a bounding box which identifies an area in the text portion containing the key word associated with a particular hyperlink. As for figures, the information for a particular figure may only need to encode the rough position of the figure, since a segmentation algorithm, as described later, will locate its true boundaries. Likewise, the code used for a particular word may not specify the precise (x,y) position of the target word. Instead, encoding merely the line number or the order of the key word may suffice while another algorithm is used to identify the correct word. Note, the key word may be located based on the manner in which it is highlighted (e.g., underlining, bold, different color, etc.) in the hardcopy document. In another embodiment, the encoded data might contain links (the actual path information) to audio or movie files, if not just text or graphics.

Stork, at column 4, lines 42-52 states:

In one embodiment, the encoded information 101 comprises machine readable information. The machine readable information may be a digital format, such as a barcode or digital paper, one embodiment of which is described in U.S. Pat. No. 5,337,362, entitled "Method and Apparatus for Placing Data Onto Plain Paper", issued on Aug. 9, 1994, and assigned to the corporate assignee of the present invention. Other types of encoding may be used in the present invention as long as identification and selection of links and their association with the "hypertext" (or active regions) in the

text are possible.

The publication Microsoft Word Tutorial "Microsoft Word Basic Features" discloses a word processing program enabling text to be displayed in bold or superscript form.

The publication Advanced Microsoft Word "Footnotes and Endnotes" discloses a word processing program enabling text to be displayed in footnote form.

C. THE REJECTION OF CLAIMS 1-3, 6, 10, 12-14, 16 and 17 AS BEING
ANTICIPATED BY STORK et al. SHOULD BE REVERSED

The Board should reverse the rejection of claims 1-3, 6, 10, 12-14, 16 and 17 as being unpatentable over Stork et al. under 35 U.S.C. § 102(e).

Responsive to the Decision on Appeal mailed November 18, 2004, the Examiner has not restated the rejection of claims 1-3, 6, 10, 12-14 and 16 under 35 USC §103 as being unpatentable over Stork et al., U.S. patent 5,781,914 in view of Kogan et al., U.S. patent 5,809,317 as set forth in the Office Action made final and mailed September 10, 2002, the Examiner now rejects claims 1-3, 6, 10, 12-14 and 16-17 under 35 USC §102(e) as being anticipated by over Stork et al., U.S. patent 5,781,914. The Notice of References Cited includes the same references as cited by the Examiner in the Office Action made final and mailed September 10, 2002.

Claims 1-2, 6 and 14 are patentable

Anticipation is a question of fact. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). The inquiry as to whether a reference anticipates a claim under

35 U.S.C. § 102 must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "read on something disclosed in the reference, i.e., all limitations in the claim are found in the reference, or 'fully met' by it."

Independent claim 1 recites a computer implemented method for identifying hypertext links in document printouts including the steps of scanning a document to be printed and identifying local hypertext links within the document, computing and storing a page location of each identified local hypertext link within the document, sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link.

The total teachings of Stork et al. do not provide any remote suggestion of the recited steps or limitations of the recited computer implemented method for identifying hypertext links in document printouts of claim 1.

The cited Stork et al. reference provides no suggestion or any means for the step of checking printable objects to identify each printable object within a hypertext anchor tag. The cited Stork et al. reference provides no suggestion or any means for or the steps of rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link; nor any suggestion or any means for

Serial No. 09/292,444

printing a corresponding uniform resource locator (URL) for each external hypertext link.

Thus, Stork et al. reference does not anticipate claim 1. Claim 1 is patentable.

The prior art of record including Stork et al. provides no teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art to achieve the claimed invention as recited in claim 1. The machine readable encoded information provided by Stork et al. is not equivalent to nor does not achieve, nor suggest the step of

rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link, as recited in claim 1 and taught by applicant.

The Examiner now maintains that Stork et al. anticipates the claimed invention as recited by claim 1, now relying upon Stork et al. for claim limitations previously indicated as missing from Stork et al. The Examiner points to column 8, lines 30-37 of Stork et al., where it is stated:

The present invention includes a process by which a hypertext document is converted into a plain paper document. One embodiment of this process is shown in FIG. 5. The hardcopy document that results contains hypertext link information in machine readable format to enable conversion back into a hypertext document format. Thus, the link information will be available to the user to enable a reversal back into a hypertext document.

The Examiner states: Compare to "**sequentially checking printable objects to**

identify each printable object within a hypertext anchor tag; and rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link."

The Examiner fails to provide any showing of why or how Stork "identifies each printable object within a hypertext anchor tag". It is unclear what teaching or disclosure of Stork suggests any use of a hypertext anchor tag. It is unclear what teaching or disclosure of Stork suggests checking printable objects to identify each printable object within a hypertext anchor tag as taught and claimed by Applicants.

The Examiner fails to provide any showing of why or how Stork "renders each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link."

The Examiner fails to provide any showing of why or how Stork "prints a corresponding uniform resource locator (URL) for each external hypertext link".

Applicants respectfully submit that the cited disclosure of Stork et al., particularly including column 8, lines 30-37, fails to disclose, expressly or under principles of inherency, the above recited limitations of the method of the invention recited in claim 1.

The Stork et al. patent does not disclose, expressly or under principles of inherency, each and every element of a claimed invention as recited in claim 1. The rejection of claim 1 under 35 U.S.C. § 102(e) is improper and should be reversed.

Stork teaches a hardcopy document that may be used to recreate a

hypertext version of the document with the correct or same link information. Stork expressly teaches providing encoded machine-readable information 101 that may be located anywhere on the document where human-readable information is not obscured (This location is referred to as a side channel). Stork, Column 4, lines 56-59.

(Emphasis added). Applicants respectfully submit that Stork fails to disclose, and provides no suggestion, of the recited claim limitation of rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link.

Applicants respectfully submit that Stork fails to disclose, expressly or under principles of inherency, this claimed limitation. Applicants submit that Stork teaches away from the claimed limitation. Stork expressly teaches providing encoded machine-readable information located anywhere on the document where human-readable information is not obscured.

Stork et al. teach during hyperdocument to hardcopy document conversion, hypertext link information is encoded and stored on the hardcopy document. Stork et al. do not disclose, nor suggest rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. Leinoff v. Louis Milona & Sons, Inc., 726 F.2d 734, 220 U.S.P.Q. 845 (Fed.

Cir. 1984).

For a claim of a patent to be "anticipated" each and every element of that claim must be disclosed in a single prior art reference. Thus, Independent claim 1 is not anticipated by Stork et al.

The Stork et al. patent does not provide for any mechanism or any motivation for sequentially checking printable objects to identify each printable object within a hypertext anchor tag. The Stork et al. patent does not provide any suggestion for use of a hypertext anchor tag. The Stork et al. patent does not provide for any mechanism or any motivation for rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link.

Stork expressly teaches providing encoded machine-readable information which is not equivalent to printing a corresponding uniform resource locator (URL) for each external hypertext link. Stork et al. reference states that "encoded information 101 comprises machine readable information. The machine readable information may be a digital format, such as a barcode or digital paper. (Column 4, lines 42-44) In accordance with the recited computer implemented method for identifying hypertext links in document printouts of independent claim 1, "printing corresponding uniform resource locator (URL) for each external hypertext link" enables a user to view a document printout and identify a hypertext link. The encoded machine-readable information of Stork et al. does not enable a user view a document printout and identify the hypertext link. The encoded machine-readable information of Stork et al. is not

equivalent to and Stork et al. do not disclose the recited limitation of printing corresponding uniform resource locator (URL).

For a claim of a patent to be "anticipated" each and every element of that claim must be disclosed in a single prior art reference. Thus, Independent claim 1 is not anticipated by Stork et al.

Stork et al. teach the use of encoded, machine-readable information to enable hypertext documents to be created automatically, without user interaction. The publications Microsoft Word Tutorial "Microsoft Word Basic Features" and Advanced Microsoft Word "Footnotes and Endnotes" add nothing to suggest the invention of claim 1. In the cited references, there is no hint of any mechanism or reason for sequentially checking printable objects to identify each printable object within a hypertext anchor tag; nor for rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link as taught and claimed by Applicants. A combination of all the teachings of the references of record would not achieve the claimed invention as recited by claim 1.

Thus, independent claim 1 is patentable and dependent claims 2, 6 and 14 are patentable.

Claims 3, 12 and 16 are patentable

Applicant respectfully submits that representative claim 3 is patentable over Stork et al. for the same reasons as claim 1.

Serial No. 09/292,444

Representative claim 3 further defines that the method of claim 1 includes the step responsive to identifying said local hypertext link, printing said identified page number for said local hypertext link with said printable object.

Stork et al. do not provide any teachings, or suggestion, of "local" and "external" hypertext links, as defined and claimed by the present application. No teachings, or suggestion, of "local" and "external" hypertext links is provided within the applied Stork et al. reference, as defined and claimed by Applicants. The Stork et al. reference neither discloses, nor suggests the recited step of responsive to identifying said local hypertext link, printing said identified page number for said local hypertext link with said printable object. While the Examiner points to column 4, lines 39-41 that states: "encoded information 101 contains hyperlink information that is used in the document to actively retrieve other portions of the document or other documents," it is unclear, just what, in the Stork et al. reference, the examiner is equating to the recited claimed limitations of: responsive to identifying said local hypertext link, printing said identified page number for said local hypertext link with said printable object.

The total teachings of Stork et al. do not provide any remote suggestion of or any incentive for the recited step of responsive to identifying said local hypertext link, printing said identified page number for said local hypertext link with said printable object.

Thus, dependent claim 3 is patentable and dependent claims 12 and 16 are patentable over all the references of record.

Claim 10 is patentable

Independent claim 10 is submitted to be separately patentable because claim 10 recites apparatus for identifying hypertext links in document printouts comprising: a stored document data, said document data including each local hypertext link name and a page number for each said local hypertext link name; and a printing program utilizing said stored document data for printing a document including a predefined indication of each hypertext link within the document to be printed including a corresponding uniform resource locator (URL) printed for each external hypertext link.

The cited Stork et al. patent does not disclose, nor suggest, such apparatus including the recited claimed subject matter of independent claim 10. The Examiner states that claim 10 is rejected under the same rationale used to reject claim 1.

Stork does not enable, nor provide any suggestion of a printing program utilizing said stored document data for printing a document including a predefined indication of each hypertext link within the document to be printed including a corresponding uniform resource locator (URL) printed for each external hypertext link, as recited in independent claim 10.

Lack of novelty can be established only where a prior invention is identical to (or "anticipates") the invention sought to be patented. "In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." Akzo N.V. v. U.S. Intern. Trade Com'n, 808 F.2d 1471, 1479 (Fed. Cir. 1986).

Thus, independent claim 10 clearly is patentable over Stork et al.

Claim 13 is patentable

Independent claim 13 recites a computer program product for implementing document printing including identification of hypertext links comprising: a recording medium; means, recorded on the recording medium, for sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and means, recorded on the recording medium, for rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including means, recorded on the recording medium, for printing a corresponding uniform resource locator (URL) for each external hypertext link.

There is no hint of any such computer program product as recited by independent claim 13 in the references of record. Independent claim 13 is patentable for the same reasons discussed above relative to independent claim 1 because claim 13 recites means, recorded on said recording medium, for sequentially checking printable objects to identify each printable object within a hypertext anchor tag. Independent claim 13 is patentable because claim 13 further recites means, recorded on said recording medium, for rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including means, recorded on the recording medium, for printing a corresponding uniform resource locator (URL) for each external hypertext link. These limitations are not suggested by the total teaching of Stork et al.

The subject matter of dependent claim 13 is not described, nor suggested in Stork et al. Thus, applicant respectfully submits that claim 13 clearly is patentable.

Serial No. 09/292,444

Claim 17 is patentable

Independent claim 17 recites a computer implemented method for identifying hypertext links in document printouts comprising the steps of: scanning a document to be printed and identifying local hypertext links within the document, computing and storing a page location of each identified local hypertext link within the document, sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link.

Applicant respectfully submits that there is no hint of the method as recited by independent claim 17 in the references of record.

Independent claim 17 is patentable because claim 17 recites the steps of sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link. These limitations are not disclosed, nor remotely suggested by the total teaching of Stork et al.

The subject matter of dependent claim 17 is not described, nor suggested in Stork et al. Thus, applicant respectfully submits that claim 17 clearly is patentable.

Applicants respectfully submit that there are significant differences between what is disclosed in the Stork et al. patent and the subject matter of the pending claims so that it is inappropriate for the Examiner to have rejected claims 1-3, 6, 10, 12-14 and 16-17 of the above-identified application under 35 U.S.C. §102

because "[i]t is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention" (Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986)). See also In re Bond, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) ("every element of the claimed invention must be identically shown in a single reference.").

D. THE REJECTION OF CLAIMS 4, 5, and 8 SHOULD BE REVERSED

The Board should reverse the rejections of claim 4, 5, and 8 as being unpatentable Stork et al. in view of Microsoft Word Tutorial "Microsoft Word Basic Features" under 35 U.S.C. § 103.

Claims 4, 5, and 8 are patentable

Each of the dependent claims 4, 5, and 8 is patentable for the same reasons discussed above relative to claim 1. Representative claim 4 is submitted to be separately patentable because claim 4 further defines that the step of printing said identified page number for said local hypertext link with said printable object includes the step of printing said identified page number in superscript form. The subject matter of dependent claim 4 is not described, nor suggested in the Stork et al. reference or in the references of record including the Microsoft Word publication.

A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teaching of the references to arrive at the claimed invention. In re Fine, 837 F.2d. 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The test for obviousness is what the

combined teachings of the references would have suggested to one of ordinary skill in the art. In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

35 U.S.C. § 103 requires that the invention as claimed be considered "as a whole" when considering whether the invention would have been obvious when it was made. Graham v. John Deere, 383 U.S. 1, 148 USPQ 459, 472 (1966). It is applicant's claimed invention which must be considered as a whole pursuant to 35 U.S.C. § 103, and failure to consider the claimed invention as a whole is an error of law.

In the words of the Court of Appeals for the Federal Circuit, "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re John R. Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992). The mere fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. See In re Gordon and Sutherland, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984), Carl Schenck, A.G. v. Nortron Corp., 713 F.2d 782, 787, 218 USPQ 698, 702 (Fed. Cir. 1983), and In re Sernaker, 702 F.2d 989, 995-96, 217 USPQ 1, 6-7 (Fed. Cir. 1983). Applicant respectfully submits that the prior art description of Stork et al., falls short of applicant's invention, and the subject matter of the claimed invention as recited in claim 4 would not have been obvious to one of ordinary skill in the art in view of the references of record.

To prevent the use of hindsight based on the invention to defeat patentability of

the invention, the Court of Appeals for the Federal Circuit requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In determining that one of skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention obvious, a motivation to choose these references for combination must be identified. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). "Virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983). ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine

patentability." Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

The Microsoft Word publications add nothing to render obvious the further defined methods for identifying hypertext links in document printouts as defined in each of the dependent claims 4, 5, and 8. Thus, Applicants respectfully submit that each of the dependent claims 4, 5, and 8 clearly is patentable.

E. THE REJECTIONS OF CLAIMS 7, and 9 SHOULD BE REVERSED

The Board should reverse the rejections of claim 7 and 9 as being unpatentable Stork et al. in view of Advanced Microsoft Word "Footnotes and Endnotes" under 35 U.S.C. § 103.

Claims 7, and 9 are patentable

Each of the dependent claims 7 and 9 is patentable for the same reasons discussed above relative to claim 1. Representative claim 7 is submitted to be separately patentable because claim 7 further defines that the step of printing said uniform resource locator (URL) for said external hypertext link is responsive to identifying said external hypertext link, and includes the steps of printing said uniform resource locator (URL) for said external hypertext link in a footnote for said printable object. The subject matter of dependent claim 7 is not described, nor suggested in the Stork et al. reference or in the references of record including the Microsoft Word publication.

A combination of all the teachings of the references of record would not achieve the claimed invention as recited by claims 7 and 9. 35 U.S.C. § 103 requires

Serial No. 09/292,444

that the invention as claimed be considered "as a whole" when considering whether the invention would have been obvious when it was made. Graham v. John Deere, 383 U.S. 1, 148 USPQ 459, 472 (1966). The prior art descriptions of the Stork et al. patent and the Microsoft Word publication fall short of applicant's invention, and the subject matter of the claimed invention would not have been obvious to one of ordinary skill in the art. The prior art provides no teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art to achieve the claimed invention.

The Microsoft Word publications adds nothing to render obvious the further defined methods for identifying hypertext links in document printouts as defined in each of the dependent claims 7, and 9. Thus, Applicants respectfully submit that each of the dependent claims 7, and 9 clearly is patentable.

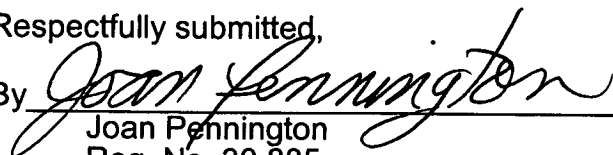
F. CONCLUSION

Each of the independent claims 1, 10, 13, and 17 distinguishes over the references of record and further their subject matter as a whole would not have been obvious at the time of the invention. Each of claims 1-10, 12-14 and 16-17 are patentable and the Examiner's rejections of claims 1-10, 12-14 and 16-17 under 35 U.S.C. § 102(e) and 35 U.S.C. § 103 should be reversed.

It is respectfully requested that the final rejection be reversed.

Respectfully submitted,

By



Joan Pennington
Reg. No. 30,885
Telephone: 312/670-0736

(8) CLAIMS APPENDIX

CLAIMS ON APPEAL

1. (Previously presented) A computer implemented method for identifying hypertext links in document printouts comprising the steps of:

scanning a document to be printed and identifying local hypertext links within the document,

computing and storing a page location of each identified local hypertext link within the document,

sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and

rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link.

2. (Previously Presented) The computer implemented method for identifying hypertext links in document printouts as recited in claim 1 wherein the step of rendering each identified printable within said hypertext anchor tag with said predefined indication of the hypertext link includes the steps of checking whether each said identified printable object within said hypertext anchor tag is a local hypertext link.

3. (Previously presented) The computer implemented method for identifying hypertext links in document printouts as recited in claim 2 includes responsive to identifying said local hypertext link, printing said identified page number for said local hypertext link with said printable object.

4. (Previously Presented) The computer implemented method for identifying hypertext links in document printouts as recited in claim 3 wherein the step of printing said identified page number for said local hypertext link with said printable object includes the step of printing said identified page number in superscript form.

5. (Previously Presented) The computer implemented method for identifying hypertext links in document printouts as recited in claim 3 wherein the step of printing said identified page number for said local hypertext link with said printable object includes the step of printing said identified page number in bold form.

6. (Previously Presented) The computer implemented method for identifying hypertext links in document printouts as recited in claim 1 wherein the step of rendering each identified printable object within said hypertext anchor tag with said predefined indication of the hypertext link including printing said corresponding uniform resource locator (URL) for each said external hypertext link includes the steps of checking whether each said identified printable object within said hypertext anchor tag is an external hypertext link.

7. (Previously Presented) The computer implemented method for identifying hypertext links in document printouts as recited in claim 6 wherein the step of printing said uniform resource locator (URL) for said external hypertext link is responsive to identifying said external hypertext link, and includes the steps of printing said uniform resource locator (URL) for said external hypertext link in a footnote for said printable object.

8. (Previously Presented) The computer implemented method for identifying hypertext links in document printouts as recited in claim 1 wherein the step of printing said uniform resource locator (URL) for said external hypertext link includes the step of printing said uniform resource locator (URL) in superscript form.

9. (Previously Presented) The computer implemented method for identifying hypertext links in document printouts as recited in claim 1 wherein the step of printing said uniform resource locator (URL) for said external hypertext link includes the step of printing said uniform resource locator (URL) in bold form.

10. (Previously Presented) Apparatus for identifying hypertext links in document printouts comprising:

a stored document data, said document data including each local hypertext link name and a page number for each said local hypertext link name; and

a printing program utilizing said stored document data for printing a document including a predefined indication of each hypertext link within the document to be printed including a corresponding uniform resource locator (URL) printed for each external hypertext link.

11. (canceled)

12. (original) Apparatus for identifying hypertext links in document printouts as recited in claim 10 wherein said predefined indication of each hypertext link within the document to be printed includes a corresponding page number printed for each local hypertext link.

13. (Previously Presented) A computer program product for implementing document printing including identification of hypertext links comprising:

a recording medium;

means, recorded on the recording medium, for sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and

means, recorded on the recording medium, for rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including means, recorded on the recording medium, for printing a corresponding uniform resource locator (URL) for each external hypertext link.

14. (original) A computer program product for implementing document printing including identification of hypertext links as recited in claim 13 includes means, recorded on the recording medium, for scanning a document to be printed and for identifying local hypertext links within the document, and means, recorded on the recording medium, for computing and storing a page location of each identified local hypertext link within the document.

15. (canceled)

16. (original) A computer program product for implementing document printing including identification of hypertext links as recited in claim 14 wherein said means, recorded on the recording medium, for rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link includes means, recorded on the recording medium, for printing said page number for each local hypertext link.

Serial No. 09/292,444

17. (new) A computer implemented method for identifying hypertext links in document printouts comprising the steps of:

scanning a document to be printed and identifying local hypertext links within the document,

computing and storing a page location of each identified local hypertext link within the document,

sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and

rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link.

Serial No. 09/292,444



(9) EVIDENCE APPENDIX
DRAWINGS OF INVENTION

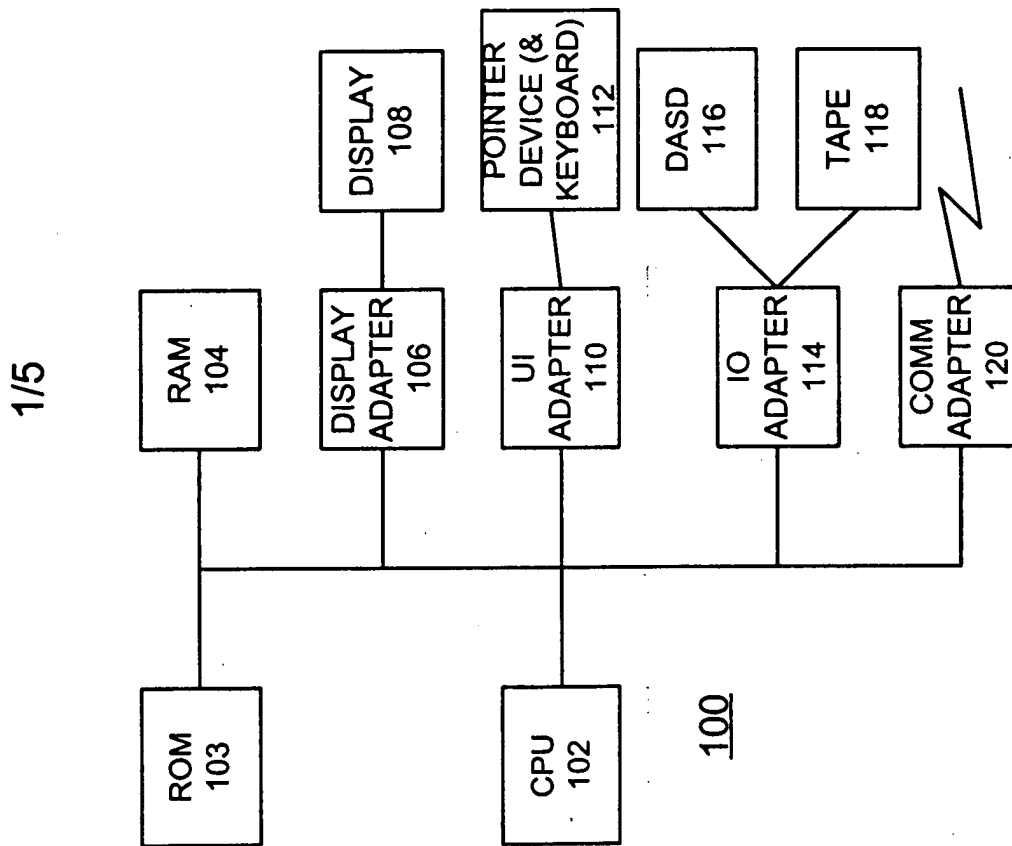


FIG. 1A

<p>HYPERTEXT REFERENCE IDENTIFICATION PRINTING PROGRAM 132</p>	<p>DOCUMENT DATA 200</p>
<p>OPERATING SYSTEM 130</p>	

FIG. 1B

DOCUMENT DATA 200

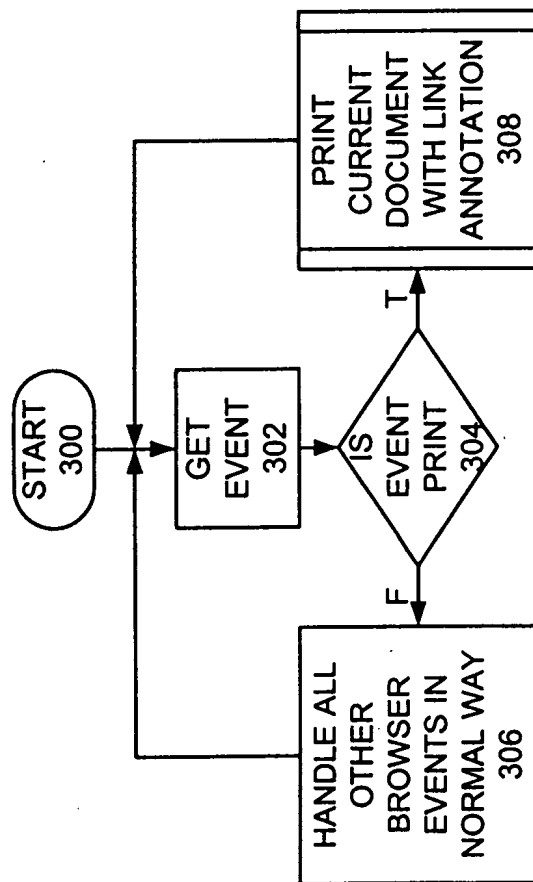
LOCAL ANCHOR NAME 202 PAGE NUMBER 204

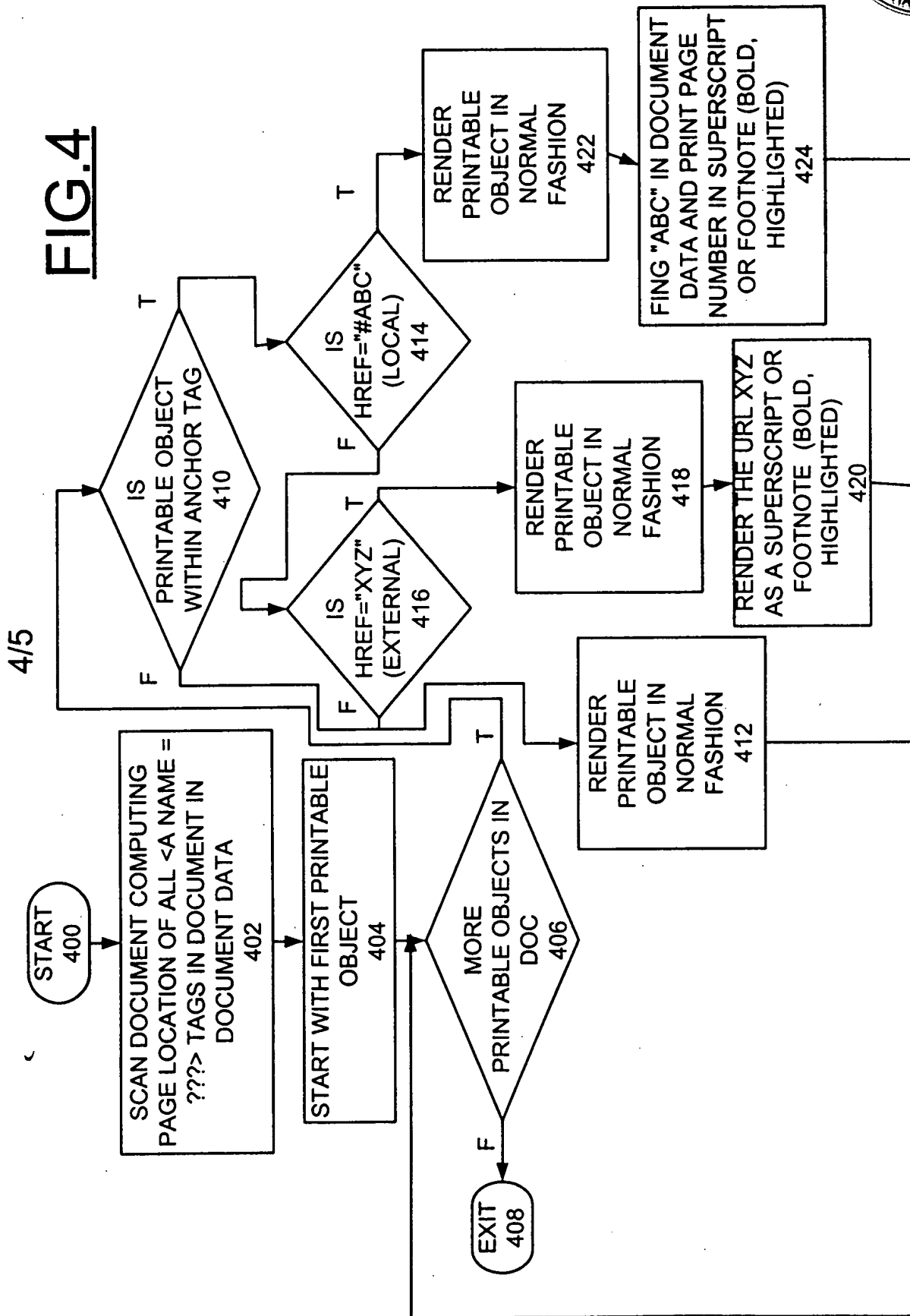
ABC	20
A1	5

FIG. 2



3/5

FIG.3





RO998-222

5/5

FIG. 5

